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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92047809
Party	Plaintiff Randall A. Terry
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RANDALL A. TERRY	)	
	)	
Petitioner	)	
	)	
v.	)	Cancellation No. 92047809
	)	Registration No. 3179591
TROY NEWMAN	)	Mark: OPERATION RESCUE
	)	
Registrant	)	
	)	
_____	)	

PETITIONER'S TRIAL MEMORANDUM

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INTRODUCTION

Petitioner, Randall A. Terry ("Terry"), submits this memorandum in accordance with Rule 2.128 to support his petition to cancel Registration No. 3179591 issued December 5, 2006 to Troy Newman ("Newman"). Terry's petition was filed July 10, 2007 to cancel the registration of the mark OPERATION RESCUE. As shown herein, Terry founded Operation Rescue, made that name famous, has been associated with that name publicly since 1987 and remains associated with that name as part of his identity. This cancellation is based solely on Section 2(a) in that the mark comprises "matter which may … falsely suggest a connection with" Terry.

STATEMENT OF THE ISSUES

Whether Newman's registration of the mark OPERATION RESCUE falsely suggests a connection with Terry under Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), as that section is currently construed.

Whether the test under Section 2(a) requires revision to align with the statutory wording that a mark "may" suggest a false connection.

Whether the test under Section 2(a) requires revision to delineate the effect of showing fame in association with an identity protected under the statute.

DESCRIPTION OF THE RECORD

Pursuant to Rule 2.122(b), the record consists of the file history of the subject registration and, as discussed below, the evidence submitted by the parties. The file history consists of an application for the mark in standard characters filed May 16, 2005 for services described as "pro-life education and activism" with a specimen of use identified as a webpage then currently in use showing the name "Operation Rescue West"

rather than the mark applied for, and asserting first use as of July 1991 and first use in commerce as of July 13, 1991 (the dates of use were never amended to reflect a date of first use before use in commerce). An Office Action issued December 13, 2005 requesting amendment to the recitation of services and a substitute specimen. Newman's response was filed June 8, 2006 with a substitute specimen showing "Operation Rescue" and an amended recitation of services as later issued: "educational services, namely, providing classes, workshops, seminars and personal instruction in the field of pro-life issues and social activism."

A. Terry's Trial Testimony (case in chief and rebuttal)

1. Terry submitted his own testimony as taken on September 30, 2010 and April 7, 2011. His direct testimony contains Exhibit 1-55 (with 14A and 24A) and Exhibits R-1—R-18 submitted with cross-examination (the complete list of Exhibits is at 262-65). An Errata Sheet was filed November 10, 2010 (Paper # 62). Terry's testimony in the rebuttal period contains Exhibits 1-6 (list at 307).

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All of the witnesses, with one exception noted below, provided direct testimony on September 28, 2010 with additional rebuttal testimony by one witness.

2. Philip "Flip" Benham's direct testimony contains Exhibits A—D and Exhibits 1—7 under cross-examination (list at 3-4). Mr. Benham is the director of the organization Operation Save America (Benham T. 6).

3. Joseph Costello's testimony contains no exhibits. Mr. Costello is self-employed in retail sales and has participated in pro-life events (Costello T. 2-3, 5).

4. Michael Hirsh's testimony contains no exhibits. Mr. Hirsh is self-employed as an attorney and has been involved in pro-life activities (Hirsh T. 4, 7).

5. Bruce Moore's testimony contains no exhibits and was taken on October 22, 2010 after the close of Terry's trial period by stipulation of the parties (Paper # 61). Mr. Moore is a minister at Clearbrook Christian Assembly (Moore T. 4).

6. Mark Allan Steiner's direct testimony contains Exhibits A—C and cross-examination contains Exhibit 1. Mr. Steiner teaches in the field of communication studies at Christopher Newport University and is the author of the book entitled *The Rhetoric of Operation Rescue: Projecting the Christian Pro-Life Message* (Steiner T. 4-5, 8).

7. Rosemarie Szostak's direct testimony contains Exhibit A comprised of her Declaration and Exhibits 1—8 thereto. Ms. Szostak is a research analyst at Nerac who conducted database searches covering news sources (Szostak T. 4-6 & Exhibit A ¶¶ 1-2). Ms. Szostak's testimony in the rebuttal period on March 16, 2011 contains Exhibit B.

8. Rusty Lee Thomas' testimony contains no exhibits. Mr. Thomas serves with Elijah Ministries and is assistant director of Operation Save America (Thomas T. 4-5).

B. Terry's Notices of Reliance

Terry's first Notice of Reliance consists of 44 articles from the New York Times (Section A), 15 articles from the Washington Post (Section B), 11 articles from other publications (Section C), and six excerpts from books (Section D). Terry's second Notice of Reliance consists of Newman's responses to Interrogatories Nos. 11 and 12. Terry's third Notice of Reliance contains 22 entries (inadvertently numbered 23 as # 8 is

missing) consisting of Whois data from 2 websites, webpages from 4 websites and 16 articles from various publications.

C. Newman's Trial Testimony

Newman did not testify on his own behalf. Witnesses testifying for him are the following:

1. Thomas Brejcha testified on January 26, 2011 and offered Exhibits 1-3. Mr. Brejcha is an attorney with the Thomas More Society (Brejcha T. 6).

2. Philip John Faustin testified on January 27, 2011 with no exhibits. Mr. Faustin has a handyman business and is executive director of Operation Rescue Colorado (Faustin T. 4-5).

3. Patrick Joseph Mahoney testified on January 28, 2011 with no exhibits. Mr. Mahoney is a minister and director of the Christian Defense Coalition (Mahoney T. 4-5).

4. Jeffrey Lee White testified on January 25, 2011 and offered Exhibits 1—9. Mr. White is a youth pastor at Lake Gregory Community Church (White T. 5).

D. Newman's Notices of Reliance

Newman's first Notice of Reliance consists of publications from newspapers, periodicals, books or websites with 12 items in Exhibit A, 3 items in Exhibit B, 28 items in Exhibit C, 34 items in Exhibit D, 23 items in Exhibit E, 10 items in Exhibit F, 4 items in Exhibit G, and 62 items in Exhibit H. Newman's second Notice of Reliance consists of Exhibit I with Terry's responses to Interrogatories Nos. 10 and 25 and Exhibit J with Terry's responses to Requests for Admissions Nos. 444-454, 477, 480-91, 502-04, 547-51, and 579-89.

Terry's evidentiary objections are submitted in the Appendix to this memorandum.

STATEMENT OF FACTS

In the fall of 1983, Terry "determined that [he] was going to embark on a lifelong mission to fight for the rights of unborn babies." (Terry T. 6.) In pursuing that mission, he adopted the name Operation Rescue; and he has continued that mission and the use of Operation Rescue to identify himself, as detailed herein. Terry testified: "[Operation Rescue] is above all a name into which I have poured my life and it is a moniker that is synonymous in many aspects with my person, my history, my leadership and my sacrifices." (Terry T. 10.)

Terry graduated in 1981 with honors from Elim Bible Institute. In the mid 1990s, he graduated with a B.A. in Christian studies from Whitfield College. He received a second B.A. in communications in 2006 from the State University of New York. (Terry T. 5.) He describes himself as self-employed through writing, public speaking, television show hosting, training people in how to work with the media, and "train[ing] people in principles of social activism and lead[ing] them in various social activist battles." (Terry T. 4.)

In May 1984, Terry "started standing in front of the local abortion clinic" (*id.* 6) and organized other like-minded activists into a group he named Project Life (*id.* 6-7). He organized a crisis pregnancy center, worked with adoption agencies, and preached to encourage participation by others. (*Id.* 7.) .) He organized sit-ins at abortion clinics in January 1986. (*Id.* 15.) Such sit-ins then were small and "five or ten [persons] was

considered very big." (*Id.*) By 1986, Project Life had attracted media coverage and "established itself as a fairly significant pro-life force in upstate New York." (*Id.* 10.)

At that time Terry's friend, David Long, suggested the name Operation Rescue and the two agreed to swap names—Long took Project Life and Terry adopted Operation Rescue. (*Id.* 10.) The name appealed to Terry: it was militant, it indicated rescuing somebody, and it had a military sound. (*Id.* 11.) "It just seemed to fit the vision that I had in my mind of where the pro-life movement needed to go as a whole and where I needed to go as a leader." (*Id.*) Terry's goals were to "save as many babies from abortion as humanly possible," by gathering hundreds, if not thousands, of people at abortion clinics, "to create a movement that rivaled and maybe even exceeded the civil rights movement of the 1960s" that "would translate into political firepower." (*Id.* 12.)[1]

In the fall of 1986, Terry "was producing literature and began preaching to people and recruiting people under the banner of Operation Rescue." (*Id.* 13.) Terry attended a pro-life rally in Pensacola, Florida and invited pro-life leaders from around the country to meet with him as he explained his plans for an event in New York City, "this wedding of the tactics of the Civil Rights movement and the pro-life cause." (*Id.* 14.) Thereafter, Terry spoke at pro-life events in South Dakota and recruited people. (*Id.*) In February 1987, he began inviting pro-life leaders to his home for planning meetings. (*Id.* 16-17.) For logistical reasons, before undertaking an event in New York City, Terry planned a first, interim event for Philadelphia for Thanksgiving weekend 1987. (*Id.* 18-20.)

[1] At least by the spring of 1986, pro-life activists had adopted the word "rescue" instead of "sit-ins" to describe events that were interventions at abortion clinics. (Terry T. 15-16.) While other evidence by Newman suggests that "rescue" may have been used earlier, Terry was not aware of any organization using that term when he adopted the name Operation Rescue (Terry T. 16.)

On Friday of that weekend, Terry held a rally of about 500 people and about 350 to 500 assembled the next morning. (*Id*. 20-21.) The Philadelphia police were aware of Terry's plan and had blocked off abortion clinics so a last-minute change in strategy led to Terry's followers descending by surprise on the clinic at Cherry Hill, New Jersey. (*Id*. 21-22.) The police there arrested 210 people.[2] (*Id*. 22.) Terry's rescue successfully closed the clinic for that day: "[W]e proved that if a large enough group of people would simply make the sacrifice of time and risk arrest that we could at least save those children on that day." (*Id*. 23.) With this momentum, Terry sent out repeated mailings and a flier called Operation Rescue (*id.* 25) and he began traveling and speaking at invitations, including the Christian oriented 700 Club started by Pat Robertson (*id.* 24).

Terry's next Operation Rescue event was May 1988 in New York City. (*Id*. 25.) Rescue events at abortion clinics spanned four days; on the first day over 800 were arrested, including 51 clergy, with the total arrested over 1600. (*Id*. 25-26.) Terry's next event was July 4-6, 1988 in Philadelphia with over 1000 people arrested and again closing clinics for days. (*Id*. 27.) In a post-event interview on CNN's show *Crossfire* with Pat Buchanan, Terry announced, without even advising his staff, that Operation Rescue would hold its next event at the national Democratic presidential convention in Atlanta, Georgia. (*Id*. 27-28.) From late July through August and again in October, Terry led Operation Rescue through a series of events in Atlanta. (*Id*. 28-32.) The press dubbed it "the siege of Atlanta." (*Id*. 29.) *See also* Terry's First Not. Reliance ¶ 72 (Current Biography Yearbook 1994 (at p. 592) and ¶ 76 *Wrath of Angels* (at p. 271-88).

[2] For purposes of civil disobedience, the number of persons arrested had significance and those statistics were closely monitored and reported by Operation Rescue. (Terry T. 88-89.)

Following Atlanta, Terry successfully urged local leaders in numerous cities to conduct events as part of a National Day of Rescue. (*Id*. 32.) In January 1989, Terry took Operation Rescue to New York City for two days of events and then to Los Angeles, California for Easter week for three days of rescues. (*Id*. 32-33.) By early 1989, however, the lawsuits against Terry and Operation Rescue had started. (*Id*. 33.) Terry was acquitted of criminal charges stemming from events in Los Angeles, but found guilty from events in Atlanta. (*Id*. 36-37.) Terry refused to pay the fine and was jailed in late September 1989. (*Id*. 37.)

While in jail, dissension arose among Terry's advisors and he felt that some had betrayed him. (*Id*. 38-39.) Upon release from jail in January 1990, Terry dismissed the man he had appointed as interim director and allowed other advisors to rejoin after he also dismissed them. (*Id*. 40-41.) Terry held a press conference announcing that he was taking Operation Rescue "underground" and he laid off most of his office personnel. (*Id*. 41.) Still, Terry conducted rescue events in 1990 in California and Binghamton, New York, but he also orchestrated a change to deal with the lawsuits piling up. (*Id*. 42.)

Terry picked Keith Tucci to be the director of a new entity called Operation Rescue National which was done in part so that the pending lawsuits would not transfer to the new entity. (*Id*. 42-43, 87.) There was an understanding between these two men that the name Operation Rescue belonged to Terry and Operation Rescue National belonged to Tucci. (*Id*. 87.) Tucci's first major rescue event for the new organization was called the Summer of Mercy held in 1991 in Wichita, Kansas. (*Id*. 43.) Terry and Tucci collaborated in the leadership of the events which lasted 40 to 50 days. (*Id*. 44.)

This collaboration continued as the rescue events called Spring of Life was conducted in Buffalo, New York in 1992 and Cities of Refuge was conducted in various cities.[3] (*Id*. 47-48.) In February 1994, Tucci turned over the directorship of Operation Rescue National to Philip "Flip" Benham. (*Id*. 48; Benham T. 6.) In 1994, a national law was passed that effectively ended rescue events at abortion clinics, the Freedom of Access to Clinic Entrances Act, also known as FACE. (Terry T. 48; Steiner T. 20-21).[4] In 1999 or 2000, Benham changed the organization's name to Operation Save America. (Benham T. 7, 45; Thomas T. 19, 21 (confirming change for activity in Buffalo, NY).)

While directing the activities of Operation Rescue, Terry began hosting a radio news program entitled Operation Rescue News Update that lasted until 1993 or 1994. (Terry T. 91 & Ex. 6.) This was a daily news show that at its peak was carried on over 200 stations. (*Id*. 92.) This show covered pro-life news and sometimes Terry was able to host it by telephone even while in jail. (*Id*. 93-94.)

Terry also began hosting a daily radio program in 1992 entitled "Randall Terry Live" that covered pro-life activities; "[i]t was a cross between Rush Limbaugh and John the Baptist." (*Id*. 49.) Terry's show was broadcast on over 100 stations in major markets until 2000. (*Id*. 50.) During the show, Terry made regular references to Operation Rescue. (*Id*.) The show itself was the topic of works by other news media. (*Id*.; *see also* Terry's First Not. Reliance ¶¶ 25 & 63.)

In 1992, Terry led protests and rescue events at the Republican and Democratic National Conventions and was arrested at both of these events. (*Id*. 53-54, 58-60.) *See*

[3] Although Terry's testimony was unclear as to 1992 or 1993 for Buffalo, 1992 was correct. *See* Terry First Not. Reliance ¶ 13.
[4] *See also* 18 U.S.C. § 248.

also Terry's First Not. Reliance ¶¶ 14-18. After the passage of FACE, rescue events declined, but Terry continued protesting at abortion clinics, conducted sidewalk counseling, assisted with crisis pregnancy centers, and other pro-life activities. (*Id*. 53.) These included protests in 1995 and 1996 against forced abortions as conducted in China and lobbying against same sex marriage in Hawaii in 1996. (*Id*. 51, 55-56.) In 1997, Terry led protests against the retail chain Barnes & Noble for sale of books containing child pornography. (*Id*. 52.) *See also* Terry's First Not. Reliance ¶¶ 23, 24 & 64.

Terry ran for the U.S. House of Representatives for the elections in 1994 and 1998. (*Id*. 56.) The latter race, in particular, garnered media attention which included references to Operation Rescue. (*Id*. 57-58.) *See also* Terry's First Not. Reliance ¶¶ 21, 26, 27, 65 & 66. In 1999-2000, Terry conducted pro-life activities and used his radio show to protest the New York campaign of Hilary Clinton for the Senate. (*Id*. 61.) Terry's political protests and his own election campaign would continue, as noted below.

In 2001, Terry organized protests in 10-11 cities against stem cell research. (*Id*. 62.) At Southern Methodist University, he debated Sarah Weddington, the attorney in the *Roe v. Wade* decision. (*Id*.) In 2003, Terry became the spokesperson for Terri Schiavo who was scheduled to be disconnected from her feeding tube. (*Id*. 62-63.) Terry engaged in public relations that included meeting with Governor Bush of Florida and "creat[ing] the firestorm necessary for a bill to be passed in Florida that saved her life." (*Id*. 64.) *See also* Terry's First Not. Reliance ¶ 31; Terry's Third Not. Reliance ¶¶ 7 & 13. The article at ¶ 7 was headlined: "Feeding-tube Dispute a Textbook Case of Activism: E-Mail Volume Shuts Down Fla. Legislature's Internet Server." After this event, Terry appeared

in 2003 on the show Anderson 360 on CNN and debated the former Surgeon General Jocelyn Elders regarding his efforts for Schiavo. (Terry T. 114-15 & Ex. 22.)

Despite Terry's efforts for Schiavo in 2003, the law that had temporarily saved her was struck down, and Terry again became a spokesperson and media strategist for Schiavo's family in 2005. (*Id*. 65.) This too garnered massive media attention and thrust Terry into the spotlight. (*Id*. 67.) *See also* Terry's First Not. Reliance ¶¶ 53 & 54. After Ms. Schiavo regrettably died, Terry campaigned in 2005-06 against the state senator who hindered passage of a new law that was aimed to benefit her. (*Id*. 67-68.) Terry's identification with Operation Rescue also played prominently in that election campaign. (*Id*. 68.) *See also* Terry's First Not. Reliance ¶ 32; Terry's Third Not. Reliance ¶¶ 12 & 14.

In February 2006, the U.S. Supreme Court issued its third and final decision in the long running dispute between the National Organization for Women, Inc. v. Scheidler and Operation Rescue (these two separate cases had been combined early on). *See* 547 U.S. 9, 126 S.Ct. 1264, 164 Led.2d 10 (2006). (Terry T. 280-81.) Terry had personally settled with the plaintiff, but continued the dispute on behalf of Operation Rescue to successfully clear the name of racketeering and other charges. (*Id*.) The case had long attracted media attention. *See* Terry' First Not. Reliance ¶¶ 41-44. This case was the second one in which Operation Rescue prevailed in the U.S. Supreme Court. *See Bray v. Alexandria Women's Health Clinic,* 506 U.S. 263, 113 S.Ct. 753, 122 L.Ed.2d 34 (1993). (Terry T. 280.) That case too attracted press coverage. *See* Terry' First Not. Reliance ¶¶ 37-40. Due to his protests, rescues and related activities, Terry has long been involved in

legal disputes and at one point had 27 lawsuits in progress, two of which caused the loss of his home through bankruptcy. (*Id*. 36, 54.)

In addition to the above-mentioned rescue events, protests, election campaigns, and court cases, Terry was frequently in the news as the go-to person for the national press as various pro-life stories unfolded over the years. (*Id*. 72.) This could include legal decisions, nominations to the Supreme Court, the use of force by anti-abortion persons, and the public debate over when human life begins. (*Id*. 73.) Since the mid 1980s, Terry also regularly attended the March for Life in Washington, D.C. that occurred annually on the January 22nd anniversary of the decision in *Roe v. Wade*. (*Id*. 73-74.)

The media, of course, also covered Terry's own activities. Television interviews included those on 60 Minutes with Leslie Stahl, 60 Minutes II with Dan Rather, Phil Donohue, Dateline, Night Line, 20-20, and ABC World News Tonight. (*Id*. 30, 45-47, 101, 122-23 & Ex. 28.) Terry was interviewed 20 to 25 times on NPR and numerous other major radio programs. (*Id*. 137-38 & Ex. 45.) Terry's interviews in magazines included Time, Rolling Stone, and Playboy Forum and a full page photo in Life. (*Id*. 46, 125-26, 135 & Ex. 32 and 33, Terry's First Not. Reliance ¶¶ 60 and 68.) Terry's activities were also covered widely by Christian-oriented publications and media. (*Id*. 30-31, 116, 126-27 & Ex. 23 and 34; Terry's First Not. Reliance ¶¶ 61 and 62.)

The media also covered the events in Terry's personal life in ways that were not always flattering, although still linked to Operation Rescue. For example, to satisfy court judgments, the National Organization for Women tried to take the frequent flyer miles accumulated by Terry; Terry's bankruptcy in 1998 became news and later in 2002 a

senator tried to amend the pending bankruptcy laws to single out Terry; a church censure of Terry was news in 2000 as was his conversion to Catholicism in 2006; and even the announcement that Terry's adopted son was gay made news in 2004. *See* Terry's First Not. Reliance ¶¶ 22, 28, 30, 49, 51 and 67. Perceived changes in character made news (*see* Terry T. 120 & Ex. 26, article entitled "Hardliner to Softy?") as well as actual changes in residence in 2008 from St. Augustine Beach, Florida to the suburbs of Washington, D.C. (*see id.* 123 & Ex. 29, article entitled "Activist Randall Terry Leaves Town" and 120-21 & Ex. 27, profile in Washington Post reprinted at Terry's First Not. Reliance ¶ 56.) One recurring press theme was Terry's so-called "comeback." (*Id*. 139.) In 2001, the New York Times profiled Terry on the front page with the headline "Icon for Abortion Protestors Is Looking for a Second Act." (*Id*. 130 & Ex. 37, reprinted in Terry's First Not. Reliance ¶ 29.) Another 2001 article was headlined "Randall Terry's New Crusade" (*id.* 103 & Ex. 12), while a 2003 article was captioned "Randall Terry Makes A Comeback" (*id.* 116 & Ex. 23).

Apart from the media coverage, Terry also promoted himself and Operation Rescue. Throughout the years, even after Terry stopped rescue events and closed his offices, Terry sent letters for promotion and fundraising that prominently identified himself as the founder of Operation Rescue. (*Id*. 95-96, 105-07, & Ex. 8, 14 and 14A.) Terry issued annotated press clippings, often a collage of headlines and excerpts, for mailing. (*Id*. 99-100, 103-04, 111 & Ex. 10, 12 and 18.) These materials would have been sent to persons on Terry's mailing list that reached 90,000 in 2003-04. (*Id*. 150.) Terry also issued press releases for media consumption. (*Id*. 120-21 & Ex. 28.)

Terry's testimony often describes the media coverage as substantial or extensive. (*See, e.g., id.* 26, 30, 34, 37, 46-47.) This characterization is amply supported by the testimony and exhibits of Ms. Szostak who conducted a search of news articles in a database covering 1116 sources, including 730 newspapers (*see* Ex. 2). The searches covered 1986 through December 6, 2006, although not all of the sources were entered into the database as of the start date. (Szostak T. 8-9.) Thus, not even all of the pertinent references may have been disclosed by the searches. In the operative time frame, the names Terry and Operation Rescue appeared in 5,477 sources, and among those sources these two names appeared in the lead or first paragraph in 976 sources and appeared in the headlines 9 times. (*See* Szostak Ex. 3). Of those 976 sources, 704 also have, in that same lead paragraph, the words founder, director, president, spokesperson or spokesman. (*Id.*) From those 976 sources, excerpts from the lead paragraph showing Terry and Operation Rescue are printed at Exhibit 8. Of those 976 sources, the earliest article from the Chicago Tribune covers Terry's first rescue event in Cherry Hill, NJ in November 1987. (*See* Exhibit 8 ¶ 976.)

Szostak's searches also focus on discrete issues. With respect to articles discussing Terry, Operation Rescue and either of his two opponents (Mr. Hinchey or Mr. King) in the election campaigns of 1998 and 2006, the search disclosed 90 sources for the former and 59 for the latter. (*See* Ex. 4.) With respect to articles discussing Terry, Operation Rescue and Ms. Schiavo or Barnes & Noble, the search disclosed, respectively, 331 articles and 65 articles. (*See* Ex. 5.) With respect to articles discussing the radio show "Randall Terry Live" and Operation Rescue, the search disclosed 55 sources. (*See* Ex. 6.)

In comparison, a search by Szostak in the same time frame cited only 22 articles containing the names Operation Rescue and Troy Newman. (*See* Exhibit 7, containing the complete text of each article with highlighting added.) Of these, 14 identified Operation Rescue with the earliest dated February 26, 2004, while 8 earlier articles dating back to September 29, 2000 identified Operation Rescue West. The earliest single article, dated October 23, 1996, identified Newman, but stated: "The protestors took their signs to Binghamton [NY] Tuesday, the home of OPERATION RESCUE founder Randall Terry."

The media coverage detailed above supports that Terry is well known and famous in reference to Operation Rescue. More pointedly, one publication—the Almanac of Famous People—succinctly lists Terry as the "[c]ontroversial leader of anti-abortion group Operation Rescue." Terry's First Not. Reliance ¶ 71. His listing in the Current Biography Yearbook 1994 also supports this status. *Id.* ¶ 72. Examples from press articles in the New York Times and Washington Post include the following characterizations of Terry: "well known" from his activities in Atlanta (*id.* ¶ 10); Terry "is an example of the most important phenomenon in American politics today" (*id.* ¶ 20); "celebrity status" (*id.* ¶ 26); "celebrity" (*id.* ¶ 46); "famous" (*id.* ¶ 49); and "fame" (*id*. ¶ 51); and "famous" (*id.* ¶ 56).

As previously noted, Newman's registration identifies educational services in the field of pro-life issues and social activism. Terry has long been involved in educational services in connection with Operation Rescue. Before launching rescue events, Terry did public speaking to raise support. (Terry T. 13-14). He has often spoken at churches and events regarding pro-life activism. (*Id*. 78; Moore T. 5-6, 26.) Terry ran his own

Christian Leadership Institute to train activists in civil disobedience. (Terry T. 77; Moore T. 9-11.) Terry's educational outreach included teaching Newman these principles. (Moore T. 12-13.) Terry spoke at colleges and disseminated tapes to educate others in the pro-life field. (Terry T. 79, 132-33 and 155 & Ex. 39, 40 and 41.) In 2007, Terry organized and conducted the twentieth anniversary of the first Operation Rescue event, called Operation Rescue XX, in Philadelphia which included teaching in multiple disciplines. (*Id*. 68-69, 109, 133-34 & Ex. 42 and 43.)

Terry is connected to the name Operation Rescue in diverse ways. (*Id*. 9-10.) Terry's first book, released in 1988, was entitled Operation Rescue. (*Id*. 141 & Ex. 46.) That same year he filed a d/b/a for himself in the name of Operation Rescue in Broome county New York. (*Id*. 81 & Ex. 1.) That same year he also produced and released a video entitled Operation Rescue. (*Id*. 146-47 & Ex. 53; Steiner T. 15, 17.) In 1990 or 1991, Terry released a music CD entitled Operation Recue. (Terry T. 130 & Ex. 38.) Under cross-examination, Terry explained that he uses the phrase "Randall Terry, the founder of Operation Rescue" as his moniker: "And the moniker that I made famous. In many ways, it's a calling card. It's a memory-jarring tool. It is a name that through enormous amounts of time, sacrifice and energy I made known internationally. So I'm connected to it." (*Id*. 245.)

Terry undoubtedly controlled Operation Rescue. (*Id*. 21 and 34, he had "sole control".) Terry's advisors served at his pleasure and he dismissed them when he wished. (*Id*. 38, 40.) The 1988 media kit for Operation Rescue is a testament to Terry's personality as infused into the name. (*Id*. 82-84 & Ex. 2.) As one witness, not part of the

Operation Rescue organization, testified, Terry was a "hands-on manager type." (Hirsh T. 33).

Despite this control, Terry oversaw the launch of the new organization named Operation Rescue National, as discussed above. Terry also permitted other organizations to adopt names such as Operation Rescue Boston, Operation Rescue Southern California, or the like when the name was joined with a geographic term, as long as the name Operation Rescue alone was his. (*Id*. 74-75.) One of the first instances of such use to occur was in connection with the siege of Atlanta wherein the local organization, headed by Mr. Hirsh, was allowed to use Operation Rescue Atlanta. (*Id*. 75; Hirsh T. 10-11.) Terry rebuked others, particularly his former advisors, when they tried to use the name just Operation Rescue. (*Id*. 75-77, 275-77.) Apropos here, Terry has no objection to the use of Operation Rescue West by Newman. (*Id*. 288-89.)

ARGUMENT

Terry first presents below an overview of the applicable statutory provision of Section 2(a) and case law. This is followed by Terry's contentions that the application of Section 2(a) should be changed in two respects, as set forth above in Issues Presented. Thereafter, Terry demonstrates that he is clearly entitled to relief in this proceeding under the existing framework of Section 2(a).

A. Section 2(a): Statute and Rationale

Section 2(a) provides in pertinent part the following:

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—(a) Consists of or comprises … matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute….

Section 2(a) as a whole contains three distinct parts and the above-quoted section requires refusal of registration for three types of marks that "all require a connection of the matter of the refused registration with 'persons, institutions, beliefs or national symbols ….'" *In re White,* 73 USPQ2d 1713, 1717 (TTAB 2004). From 1969 to 1983, the Board, relying on decisions of the Court of Customs and Patent Appeals, had interpreted Section 2(a) as essentially requiring a showing of likelihood of confusion "plus a showing of intent to trade upon the goodwill of a prior user…." *Id.* at 1718.

In 1983, the Federal Circuit issued its seminal decision in *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.,* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Under that case, the Board has reasoned as follows:

> The *Notre Dame* decision then laid down certain foundational principles for current Section 2(a) analysis: that Section 2(a) was intended by the drafters to preclude registration of a mark which conflicts with another's rights, even if such rights were not technical trademark or trade name rights that could be the basis for a Section 2(d) claim; that a name cannot, however, be protected in gross; that protection from false suggestion under Section 2(a) has its roots in the rights of privacy and publicity, i.e., a right to control use of one's identity; that the name or an equivalent thereof claimed to be appropriated must be unmistakably associated with a particular personality or "persona"; and that given the context or circumstance of use, the name must point uniquely to the other personality or persona.

In re White, 73 USPQ2d at 1718 (citing *Notre Dame* 217 USPQ at 508-09).

While the right of privacy within Section 2(a) has application with regard to disparagement, *Greyhound Corp. v. Both Worlds Inc.,* 6 USPQ2d 1635, 1639 (TTAB 1988), the right of publicity is "a right to control the use of one's identity. …" *Notre Dame,* 217 USPQ at 509.

> The right of publicity is the inherent right of every human being to control the commercial use of his or her identity. This legal right is infringed by unpermitted use which will likely damage the commercial value of this inherent right of

> human identity and which is not immunized by principles of free speech and free press.

J. Thomas McCarthy, 5 McCarthy on Trademarks and Unfair Competition, § 28:1 (2011).

Related thereto, is the concept of persona:

> The term "persona" is increasingly used as a label to signify the cluster of commercial values embodied in personal identity. There are many ways in which a "persona" is identifiable: name, nickname, voice, picture, performing style, distinctive costume or character, and other indicia closely identified with a person.

Id. at § 28:7.

The right of publicity has been broadly interpreted to take many forms. In *Notre Dame*, 217 USPQ at 509, and *Buffet v. Chi-Chi's, Inc.,* 226 USPQ 428, 429 n. 4 (TTAB 1985), a broad interpretation was endorsed in each decision relying on *Carson v. Here's Johnny Portable Toilets, Inc.,* 698 F.2d 831, 218 USPQ 1 (6th Cir. 1983) (spoken introduction of "Here's Johnny" as a right of publicity). For support, the *Carson* court cited as a protectable right of publicity *Motschenbacher v. R.J. Reynolds, Inc.,* 498 F.2d 821 (9th Cir. 1974) (distinctive design of a race car); *Ali v. Playgirl, Inc.,* 447 F.Supp. 723, 206 USPQ 1021 (S.D.N.Y. 1978) (drawing of a nude, black man in a boxing ring labeled "Mystery Man"), *Hirsch v. S.C. Johnson & Son, Inc.,* 90 Wis.2d 379, 205 USPQ 920 (1979) ("Crazylegs" nickname). *Carson,* 218 USPQ at 4. *See also Waits v. Frito-Lay Inc.*, 978 F.2d 1093, 23 USPQ2d 1721 (9th Cir. 1992) (vocal style of singing); *Midler v. Ford Motor Co.,* 849 F.2d 460, 7 USPQ2d 1398 (9th Cir. 1988) (same); *Int-Elect Engineering Inc. v. Clinton Harley Corp.,* 27 USPQ2d 1631 (N.D. Cal. 1993) (motorcycle with a billowing U.S. flag painted on the side was a protectable likeness).

Under this interpretation, the Board has found a protectable persona for a person in, for example, the nickname Twiggy, *Hornby v. TJX Companies, Inc.,* 87 USPQ2d 1411

(TTAB 2008), a Native American tribal name, *White, supra,* a portrait of Ernest Hemingway, *In re Sloppy Joe's Int'l,* 43 USPQ2d 1350 (TTAB 1997), the nickname "Bo Ball", *In re Sauer,* 27 USPQ2d 1073 (TTAB 1983), and the song title "Mararitaville", *Buffet, supra.* While the range of persona protected in court may exceed that which is registrable at the Office, the Office recognizes non-traditional marks such as scents and sound marks (TMEP 1202. 13 and 1202.15), and thus the concept of persona must remain broadly interpreted.

The right of publicity "is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors and having little to do with feelings or reputation". *Zacchini v. Scripps-Howard Broadcasting Co.,* 433 U.S. 562, 205 USPQ 741, 747 (1977)

> "The rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay."

Zacchini, 205 USPQ at 748 (bracketed words in original) (quoting Kalvern, Privacy in Tort Law—Were Warren and Brandeis Wrong? 31 Law & Contemp. Prob. 326, 331 (1966)). "The rights protected under the § 2(a) false suggestion provision are not designed primarily to protect the public, but to protect persons and institutions from exploitation of their persona." *Bridgestone/Firestone Research, Inc. v. Automobile Club de L'Ouest de la France,* 245 F.2d 1359, 58 USPQ2d 1460, 1463 (Fed. Cir. 2001).

B. Section 2(a): Case Law Elements

The elements for a Section 2(a) claim need only be proven by a preponderance of the evidence. *Harjo v. Pro-Football Inc.,* 50 USPQ2d 1705, 1735 n. 90 (TTAB 1999) (§ 2(a) disparagement), *rev'd,* 284 F.Supp2d 96 (D.D.C. 2003), *remanded,* 415 F.3d 44

(D.C. Cir. 2005), *on remand,* 567 F.Supp.2d 46 (D.D.C. 2008), *aff'd,* 565 F.3d 880 (D.C. Cir. 2009), *cert. denied,* 130 S.Ct. 631 (2009); *Bridgestone/Firestone Research, Inc. v. Automobile Club de L'Ouest de la France,* 1999 WL 556473 at *7 (TTAB 1998) (§ 2(a) false connection, non-precedential), *rev'd on other grounds,* 245 F.2d 1359, 58 USPQ2d 1460 (Fed. Cir. 2001).

Based on the *Notre Dame* decision, the Section 2(a) analysis has four elements:

> 1) that the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the person or institution named by the mark is not connected with the activities performed by applicant under the mark; and (4) the fame or reputation of the person is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

In re White, 73 USPQ2d at 1718.

With respect to the first element, as compared with the test for disparagement requiring a mark to be reasonably understood as referring to a person, "the determination of whether the mark is a 'close approximation' of opposer's identity is a more stringent one, requiring a greater degree of similarity between the two designations." *Boston Red Sox Baseball Club LP v. Sherman,* 88 USPQ2d 1581, 1593 (TTAB 2008). *Cf. In re North American Free Trade Assoc.,* 43 USPQ2d 1282, 1285 (TTAB 1997) ("One cannot overcome a refusal based on a false suggestion of a connection merely by adding a design element to an entity or institution's identity").

With respect to the second element, the subject mark must point uniquely to the other's identity, but that does not mean that the mark must be a unique term. *Hornby,* 87 USPQ2d at 1426. "Rather, in the context of respondent's goods, we must determine whether consumers would view the mark as pointing only to petitioner, or whether they

would perceive it to have a different meaning." *Id.* "[T]he question is not whether the term is unique but whether, as used on the respondent's goods, it would point uniquely to petitioner." *Id.* at 1427. A finding of fame or reputation (the fourth element discussed below) can also demonstrate that the identity is unmistakably associated with the owner of the identity. *Id.* at 1426. A reasonable relationship between the respective goods and/or services of the owners of the mark and the identity asserted can support the conclusion that the mark points uniquely to the owner's identity. *See id.* at 1426-27 ("the obvious connection between models and clothing is further support for our conclusion that respondent's mark for children's clothing points uniquely to petitioner"). *See also In re Peter S. Herrick P.A.,* 91 USPQ2d 1505, 1508 (TTAB 2009) (applicant's applied-for legal services concentrated in U.S. customs law related to the identity of the U.S. Customs and Border Protection). As to whether the mark may have another meaning for the owner's goods or services, the Board in *Hornby* noted:

> Although it is not respondent's burden to explain why it adopted its mark, respondent's choice not to do so means we do not have any explanation which might show that the term has another significance when used for children's clothing.

87 USPQ2d at 1426. *See also Board of Trustees of the Univ. of Alabama v. BAMA-Werke Curt Baumann,* 231 USPQ 408, 411 (TTAB 1986) ("respondent has failed to show that, at the time of issuance of its registration, the term BAMA had any other significance"). *Cf. Notre Dame,* 217 USPQ at 510 (applicant inspired by cathedral in Paris, not Indiana university, in choosing mark for French cheese); *Rotary Int'l v. Rotary Eng. Co.,* 121 USPQ 226 (TTAB 1959) (mark ROTARY as applied to well logging services immediately suggests another meaning, not the well known fraternal organization).

With respect to the third element for a connection between the respective owners of the mark and the asserted identity, "a commercial connection, such as an ownership interest or commercial endorsement or sponsorship of applicant's services, would be necessary" to obtain registration. *In re Sloppy Joe's,* 43 USPQ2d at 1354. Likewise, a connection through an implied consent is narrowly construed and must establish a clear consent to register the mark. *See id.*

With respect to the fourth element for sufficient fame or reputation such that a connection would be presumed, the required showing is fame *or* reputation. *See Association pour la Defense et la Promotion de L'Oeurve de Marc Chagall dite Comite Marc Chagall v. Bondarchuk,* 82 USPQ2d 1838, 1843 (TTAB 2007). Further, the type of fame for § 2(a) is unlike the requirements for fame to establish a likelihood of confusion or dilution. *Id.* at 1844. *See also White,* 73 USPQ2d at 1720 (same). The fame or reputation need not be nationwide. *See Association pour la Defense et la Promotion,* 82 USPQ2d at 1844 (displays of the paintings of Marc Chagall in several major U.S. cities in several regions was sufficient); *White,* 73 USPQ2d at 1721 (Apache tribes "would be well known among residents of the southwestern U.S. and visitors to those areas"). The fame or reputation must be established as of the issuance of the registration. *See Hornby,* 87 USPQ2d at 1416 and 1424. *But see Alabama Board of Trustees,* 231 USPQ at 410 (the Board seemed to accept the petitioner's position that all of the elements must be established as of the registration's issuance). Nevertheless, "evidence of petitioner's fame or reputation *after* the date of issuance of respondent's registration may tell us something about the fame or reputation as of that date." *Hornby*, 87 USPQ2d at 1416 (emphasis in original).

With respect to whether a connection would be presumed between the goods or services of the mark's owner and the identity of its owner (the second component of the fourth element), again, as in the second element discussed above linking models and clothing, a reasonable relationship between the two leads to the requisite presumed connection. Thus, for example, in *White,* cigarette consumers aware of Native American marketing of cigarettes would presume a connection between the identity of the Apache tribe and the applicant's cigarettes branded as Apache. *See White,* 73 USPQ2d at 1722. *See also Peter S. Herrick,* 91 USPQ2d at 1508-09 (applicant's legal services and legal enforcement by U.S. Customs); *North Am. Free Trade Assoc.,* 43 USPQ2d at 1286 (applicant's promotion of trade and investment closely related to activities under the NAFTA treaty); *In re Cotter & Co.,* 228 USPQ 202, 205 (TTAB 1985) (applicant's firearms branded West Point related to a military post or reservation). When assessing this connection, "[w]hat we must determine is the initial reaction or impact of the mark when viewed in conjunction with the applicable goods or services." *In re National Intelligence Academy,* 190 USPQ 570, 572 (TTAB 1976). Conversely, what consumers can learn later to dispel this presumed connection is immaterial. *See North Am. Free Trade Assoc.,* 43 USPQ2d at 1286-87.

C. The Role of Intent Under Section 2(a)

A showing of the mark's owner's intent to usurp the identity of its owner is not required to establish a false connection under § 2(a). *See Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.,* 228 USPQ 752 (TTAB 1985). *See also In re National Collection & Credit Control, Inc.,* 152 USPQ 200, 201 (TTAB 1966) ("The question of whether or not applicant may have intended to mislead the public is not germane to the

issue herein"). Nevertheless, proof of intent to usurp another's identity is highly persuasive of a violation of § 2(a). *See Association pour la Defense et la Promotion,* 82 USPQ2d at 1843 (inference "that respondent regarded the name of Marc Chagall as one of significant reputation which would generate good will in the sale of respondent's vodka") and 1845 (an intent to suggest a connection with the owner's identity is highly persuasive) (relying on *Sloppy Joe's Int'l,* 43 USPQ2d at 1354).

Inferences of an intent to suggest a connection for its benefit to the owner of the mark can be found based on the virtually identical nature of the mark compared to the owner's identity, *Peter S. Herrick,* 91 USPQ2d at 1509, and based on the knowledge of the mark's owner of the owner's identity, *North Am. Free Trade Assoc.,* 43 USPQ2d at 1287. In the *Carson* case, the defendant admitted that he knew Johnny Carson was identified by the words "Here's Johnny" and that was why he chose those words for the products. 218 USPQ at 5. The Sixth Circuit thus vacated judgment for the defendant and awarded judgment to Johnny Carson: "The proof showed without question that [defendant] had appropriated Carson's identity in connection with its corporate name and its products." *Id.* Thus, a clear intent establishes without question a clear violation of the owner's identity.

D. Section 2(a) Violated If a Mark "May" Falsely Suggest a Connection

The statutory wording of Section 2(a) is clear that the prohibition on registration is established if the mark "may" falsely suggest a connection to a person. The Board's present case law does not provide effect to this statutory direction. More specifically, under the fourth element of the current Section 2(a) analysis, as discussed above, the question is "whether a connection with the person or institution would be presumed."

The word "would" is the past tense of "will" which, by any standard definition, means a certainty, or a requirement or command. *See, e.g.,* American Heritage Dictionary of the English Language 1465 (1969). *See also* Black's Law Dictionary 1433 (5th Ed.): "An auxiliary verb commonly having the mandatory sense of 'shall' or 'must.' It is a word of certainty, while the word 'may' is one of speculation and uncertainty." In contrast, the word "may" means a possibility. *See American Heritage,* at 808.

In interpreting a statute, the Federal Circuit, and its predecessor court, has been clear, in various contexts, that a statutory word is to be given its common and ordinary meaning and that meaning can be provided by a dictionary. *See, e.g., Bayer AG v. Housey Pharmaceuticals, Inc.,* 340 F.3d 1367, 68 USPQ2d 1001, 1004 (Fed. Cir. 2003). Further, every word should be given effect and not rendered superfluous by a statutory construction. *See In re Nantucket, Inc.,* 677 F.2d 95, 213 USPQ 889, 892 (CCPA 1982).

The use of "may" in Section 2(a) must be contrasted with the prohibition of registration within Section 2(d) for a mark "likely" to cause confusion. *Cf. Notre Dame,* 217 USPQ at 507-08 (deriving interpretation of § 2(a) by contrast with § 2(d)). "Likely" means a probability. *See American Heritage,* at 757. This is the standard construction given to analysis for a likelihood of confusion. *See* McCarthy at § 23:3 (captioned "Likelihood" is synonymous with a "probability"). *See also Electronic Design & Sales Inc. v. Electronic Data Systems Corp.,* 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) ("[w]e are not concerned with mere theoretical possibilities of confusion") (quoting *Witco Chemical Co. v. Whitfield Chemical Co.,* 418 F.2d 403, 164 USPQ 43, 44 (CCPA 1969)). Because "may" and "likely" are used within the same statute, they should be given their respective meanings of "possibility" and "probability." *See*

Farmers and Merchants Bank of Monroe, N.C. v. Federal Reserve Bank of Richmond, Va., 262 U.S. 649, 663, 43 S.Ct. 651, 67 L.Ed. 1157 (1923) (use of "may" and "shall" in same act construed, respectively, as permissive or mandatory).

The sparse legislative history of Section 2(a), reprinted in the Appendix to the *Notre Dame* decision, lends support. The draft of this section then being considered in 1939 prohibited a mark "which tends to disparage persons …." The word "tend" means to be likely, disposed or inclined. *See American Heritage,* at 1325. That meaning indicates a shading towards a "possibility" particularly since the draft then under consideration also used the standard of "likely" confusion in § 2(d).

The decision in *Notre Dame* does not compel the present interpretation by the Board to not give effect to the word "may." Indeed, the decision is essentially silent on the construction of the fourth element as currently applied. The "foundational principles" derived from *Notre Dame* (quoted above from *White,* 73 USPQ2d at 1718) do not mention the Board's current construction for a connection that would be presumed between the mark as applied and the person's identity. On the other hand, the preferred interpretation of "may" is not inconsistent with *Notre Dame.* The Federal Circuit stated that even without a likelihood of confusion under a theory of sponsorship or endorsement, "nevertheless, one's right of privacy, or the related right of publicity, may be violated." 217 USPQ at 509.

In addition to the foregoing analysis, the most compelling reason to use the ordinary meaning of "may" is that the Board did precisely that before the Board adopted its analysis—discarded after *Notre Dame*—of construing Section 2(a) as likelihood of confusion plus intent, as discussed above from *In re White,* 73 USPQ2d at 1718. Before

the Board was constrained to adopt that analysis, the Board construed "may" with its common meaning. *See In re National Collection & Credit Control, Inc.,* 152 USPQ 200, 201 (TTAB 1966) ("our statute prohibits registration of a mark which *may* disparage or falsely suggest a connection with national symbols") (emphasis in original). *See also Sterling Silversmiths Guild of Am. v. Kirk's Ltd.,* 153 USPQ 85, 87 (TTAB 1967) ("persons in this trade may well suppose that [applicant's product] is endorsed by, sponsored by or is in some way connected with opposer");[5] *Ox-Bo Black Creek Ranch v. The Ox-Bow Corp.,* 149 USPQ 654, 655 (TTAB 1966) ("persons familiar with opposer's enterprise … might well suppose, upon encountering applicant's restaurant … that the beef served therein emanates from opposer"); *Gavel Club v. Toastmasters Int'l,* 127 USPQ 88, 94 (TTAB 1960) ("persons familiar with opposer club … might well associate one with the other"). In at least one post-*Notre Dame* case, the Board used "may" as the standard for determining whether the connection between the applicant's services and the cited identity (NAFTA) would be presumed; the Board stated, "Or they [*i.e.,* consumers] may believe that applicant's services are sponsored or approved by NAFTA …." *North Am. Free Trade Assoc.,* 43 USPQ2d at 1286-87.

The construction of "may" within Section 2(a) was considered in *In re Marquette Nat'l Life Ins. Co.,* 186 USPQ 364 (TTAB 1975). The examiner refused registration to the mark MAGNAMEDICARE for underwriting medical insurance related to the federal program for the aged, *i.e.,* the program popularly known as "medicare" which the Board determined was a generic word. The Board indicated the examiner overstressed the word

[5] Even after *Notre Dame,* the Board has at times continued to use a standard of "endorsed or sponsored by" in finding a false connection. *See U.S. Navy v. U.S. Mfg. Co.,* 2 USPQ2d 1254, 1260 (TTAB 1987); *In re Cotter,* 228 USPQ at 205.

"may" referring to "the indefinite opinion of the Examiner, an opinion which is bottomed only on the fact that the term 'may' is used in Section 2(a)." *Id.* at 365. The Board interpreted "may" as a "reasonable likelihood": "We cannot give the term 'may' a broad and indefinite meaning so encompassing as to contravene the evidence presented." *Id.* at 365-66.

Terry contends that the standard of a "reasonable likelihood" is incorrect under *Notre Dame*, and for the additional reasons stated above, because Section 2(a) must be differentiated from the standard under Section 2(d). Nevertheless, the Board's rejection of an over encompassing meaning is sound and weighs in favor of a standard of reasonableness. Thus, using the ordinary meaning of "may" and this standard, the construction of "may" as a "reasonable possibility" excludes mere conjecture, while giving effect to the statutory language and the construction of the statute as a whole with respect to Sections 2(a) and (d). Terry contends this construction should be applied to the case law elements so that the conclusion of the fourth element would state "a connection with the person or institution *may* be presumed" with "may" interpreted as a reasonable possibility.

E. The Effect of Showing Fame Under Section 2(a)

As discussed above, the fourth case law element permits a showing of fame *or* reputation. A showing of fame in the context of likelihood of confusion under Section 2(d) or dilution under Section 43(c) advances benefits to the owner of a mark. However, it is not clear from the case law under Section 2(a) if there is any benefit in showing fame as compared with a showing of reputation. This lack of clarity is compounded because the case law is not always clear as to whether fame or reputation is being accorded to the

asserted identity. *See, e.g., Hornby,* 87 USPQ2d at 1425-26 (referring to "sufficient fame and reputation," "sufficient fame or reputation" and evidence to support a finding of "fame and/or reputation").

Terry contends that the principles under Section 2(c) should be adapted to Section 2(a) to provide clarity. Section 2(c), in pertinent part, prohibits registration of a mark that "consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent …." The similarity to a person's persona (name, portrait or signature) under § 2(a) is readily apparent, as is the element of consent. The parallels between Sections 2(a) and (c) have been noted: *see Notre Dame,* 217 USPQ at 509 n. 8; *In re Hoefflin,* 97 USPQ2d 1174, 1176 (TTAB 2010); and *Ross v. Analytical Technology Inc.,* 51 USPQ2d 1269, 1275-76 n. 14 (TTAB 1999).[6]

In determining under Section 2(c) whether a particular living person with a name would be associated with a mark as to certain goods, the test is "(1) if the person is so well known that the public would reasonably assume the connection, or (2) if the individual is publicly connected with the business in which the mark is being used." *Hoefflin,* 97 USPQ2d at 1176. The Board, referring to case law dealing with shirts or electrodes as "the business in which the mark is being used," summarized as follows:

> While lesser-known figures … may have to show that the consuming public connects them with the manufacturing or marketing of shirts or electrodes, for example, well-known individuals such as celebrities and world famous political figures are entitled to the protection of Section 2(c) without having to evidence a connection with the involved goods or services.

Hoefflin, 97 USPQ2d at 1177.

[6] These two statutory prohibitions obviously differ in certain respects, *see* McCarthy § 13:38, but these are not pertinent to the position presented here.

This test under Section 2(c) should be adapted to Section 2(a) in that a showing of fame by the person (*e.g.,* the celebrity) would create a presumption of a connection between the person's identity and the mark, regardless of the goods or services identified by the mark. On the other hand, a showing of just reputation by a lesser-know figure would not receive a presumption of a connection outside of the business field in which the reputation has been established.

Terry contends that the above-noted construction would not harm the application of Section 2(a), although it would emphasize more the test under the second case law element of whether the mark points uniquely to the person's identity, and that emphasis is consistent with *Notre Dame*. This application can be shown by re-analyzing several cases. In the *Rotary Int'l* case, the name Rotary could be deemed famous and thus, as contended here, a presumption would arise that there is a connection between that name for a fraternal organization and well logging services; however, the fraternal organization should still not prevail since the mark had an accepted meaning for well logging services and thus did not point uniquely to the fraternal organization. In *In re Brumberger Co., Inc.,* 200 USPQ 475, 476 (TTAB 1978), applicant sought to register a design for a toy bank that "appears to be an exact replica of an official United States mail depository box" and registration was refused under Section 2(a). The official U.S. mail box design is arguably famous and a therefore a presumption of a connection could have arisen for seemingly disparate goods and services, but the same result as ruled by the Board should be achieved even with this presumption since the official design undoubtedly pointed to no one other than the U.S mail. In the case involving the name of Marc Chagall, *Association pour la Defense et la Promotion,* that name was arguably famous; even

though there is no reasonable relationship between his fame as an artist and the applicant's vodka, the result of the case would still be the same since the name Marc Chagall did not point to anything other than the famous artist. This mode can be applied to a hypothetical case based on *Hoefflin*. In that case the mark was "Obama Pajama" for pajamas. Under Section 2(a), and assuming a famous identity exists for the words "Obama Pajama", there would be a presumed connection despite the lack of a relationship between the presidency and pajamas, and the result would then turn on the factual issue of whether the identity uniquely pointed to the President. Admittedly, this analysis uses a hypothetical (since *Hoefflin* was decided under Section 2(c)) and re-interprets the Marc Chagall case since that decision ultimately turned on the applicant's intent. This analysis is necessitated because there are few published cases wherein the identity is truly famous, yet there is no relationship between the business field of the fame for the opposer and the applicant's goods at issue. The *Rotary Int'l* and *Brumberger* cases appear as the most readily available examples to illustrate this point.

F. Newman's Registration of OPERATION RESCUE Is Prohibited by Section 2(a)

With respect to the four elements to be proven in this action, two of them are not in serious dispute. As to the first element, the facts show that Terry organized and conducted pro-life activities at least as early as November 1987 using the identification Operation Rescue, and that Terry's identity as Operation Rescue is identical to the mark as registered by Newman. The third element is proven by the pleadings: Terry's last-amended petition stated in paragraph 5: "Petitioner is not connected in any way with the services identified by Registrant's use of the mark OPERATION RESCUE" (Paper # 23,

Exhibit A to the motion filed May 27, 2008); and Newman's response thereto stated "Admitted" (Paper # 28 filed December 14, 2008).

To embellish on the first element, the name Operation Rescue is clearly associated with, and part of, Terry's identity. That name is the name of Terry's book, video, music CD, and radio news program, and is the d/b/a that Terry registered in order to conduct the business of the organization that he founded, led and controlled. Terry controlled that organization and its name from the date of creation until Terry decided that the organization should cease its existence. At that point, he shepherded the activities of the organization to another person who used a different name for his organization. Thereafter, Terry continued to identify himself as Operation Rescue or, viewed another way, he continued to claim the legacy of that organization by identifying himself as its founder. As Terry testified, "In many ways, it's a calling card. It is a memory-jarring tool." (Terry T. 245.) Terry has used that calling card throughout his career and the media has repeated it, and continues to repeat it, as shown in the news coverage discussed in the Statement of Facts. Operation Rescue is not just an identity that Terry asserts when conducting his own activities, whether protests, newsletters or public speaking, it is an identity that is clearly used by others, particularly the media, to identify him—to jar the memory of the reader or viewer so that each knows that any current point under consideration is linked to Terry, the man who made headlines and changed the national landscape of pro-life activities as well as the national debate between pro-life and pro-choice proponents.[7]

[7] An example illustrates an impact by Terry on the pro-choice movement. In 1996, Jill Ireland, then the president of the National Organization for Women, published her book What Women Want with a lengthy account of how Terry's Operation Rescue influenced NOW in its strategy. *See* Terry's First Not. Reliance ¶ 74.

As to the second element, Newman's mark points uniquely and unmistakably to Terry.[8] Newman's mark covers educational services in the field of pro-life issues and social activism. Terry is renowned (actually, famous, as discussed below) in the field of pro-life issues and social activism, including related educational services. In that field, there is no evidence of any use of Operation Rescue apart from Terry and Newman's belated use to secure his registration. As Terry testified, he kept others, such as former advisors, from using that name. When needed, Terry persuaded others to adopt a name different from Terry's identity, as shown early on with the adoption of Operation Rescue Atlanta.

Any use of Operation Rescue Atlanta or a similar name does not detract from the fact that Operation Rescue points uniquely to Terry. In the first place, Newman would have not sought to register the name, and capitalize on its cache, if it was already marginalized by the use of those similar names (this point is elaborated on in discussing below Newman's intent). Second, use by others of merely a similar name should not be given weight. The test for the owner of an identity is to show that the mark at issue is the same or a close approximation, and under the case law this is a stringent test. *See, e.g., In re Kayser-Roth Corp.,* 29 USPQ2d 1379, 1385 (TTAB 1993) (mark Olympic Champion not a close approximation of Olympic). As a corollary principle, use by others of a mere similar name (as contrasted with use of a close approximation) does not detract from a unique identity. The scope of that identity may be narrowly defined under Section 2(a),

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[8] This conclusion is supported not only by Terry's testimony, but by other witnesses. *See* Benham T. 90; Hirsh T. 18; and Steiner T. 19-20. Both Benham and Steiner have been otherwise critical of Terry. *See* Benham T. 88-89 and Steiner T. 14.

but Newman did not seek to register Operation Rescue Atlanta or Operation Rescue West, for example.

A related point was made in *NASA v. Record Chemical Co., Inc.,* 185 USPQ 563 (TTAB 1975). Therein, applicant sought registration of the mark APOLLO 8 for moth proofing products and NASA opposed based on its historic spaceflight of the same name under Sections 2(a) and (d). Referring to both of those sections, the applicant argued that NASA was not damaged in view of third-party use of Apollo or Apollo combined with a numeral other than 8. The Board rejected that argument since "the question under consideration is not the extent of NASA's rights in and to the designation "APOLLO", per se, but whether applicant has the right to register "APOLLO 8" over NASA's prior use of the identical designation." *Id.* at 567.[9]

The fourth case law element has two components—a showing of fame or reputation, and a showing that a connection would be presumed between the persona and the services identified by the mark. As set forth in the Statement of Facts, there is ample proof that Terry's identity as Operation Rescue is famous as shown by his listing in the Almanac of Famous People and the abundant media coverage, including the names of Terry and Operation Rescue appearing together in 9 headlines of news sources.

Although the foregoing is sufficient, this fame is also shown by other diverse evidence that shows Terry's impact on a broad spectrum of American culture. In 2000, the Washington Post published a review on a television movie called "Running Mates" with Tom Selleck as a presidential candidate. *See* Terry's First Not. Reliance ¶ 50. The reviewer describes a minor character in the movie as follows:

> The white-knight senator from Colorado is given the name "Terrence Randall." Surely giving this name to a character who is an abortion rights advocate and including a scene of an abortion clinic bombing is a sly jab at Randall Terry, the Operation Rescue antiabortion zealot and sometimes candidate.

Id. The review itself does not bolster Terry's fame, but the movie's significance is in making a parody of Terry. To even offer that parody presumes a wide ranging knowledge of Terry's Operation Rescue on behalf of television viewers to "get the joke" since one does not parody the obscure or unknown. Terry's connection to Operation Rescue also arose as the subject of a question on the popular television program Who Wants to be a Millionaire then hosted by Regis Philbin. (Terry T. 286-87). Again, that presumes a wide ranging knowledge on behalf of viewers. Terry's fame has also spurred various opponents to specifically use his name to spur fundraising to support causes contrary to those of Terry's (Terry T. 288) and, in similar fashion, his opponents on the abortion issues, NOW and Planned Parenthood, used references to him to recruit their activists (Terry T. 37). In yet a different example of Terry's status, his essay on abortion clinic shootings was chosen as part of an anthology of essays for a college text book on writing and critical thinking. Terry's First Not. Reliance ¶ 75. In 1997, the President of China visited the United States and the Washington Post reported, as the story's opening theme, the comments of Secretary of State Albright and Senator Kerry that it was important for the Chinese President to see American protestors; the Post's photo with the story showed "Randall Terry of Operation Rescue" demonstrating at the White House where some protestors were arrested. *Id.* ¶ 48. In all, Terry's identity has spread beyond the news headlines and into the broader culture, which is surely an indicia of fame.

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[9] The utility of the case for further analogy ends there since, at that time, the Board followed the since-discarded view that required a showing of likelihood of confusion for Section 2(a).

The second component is the presumed connection between Terry's persona and the services identified by Newman's registration. As discussed in the above analysis of this component, a reasonable relationship between the two is sufficient to establish this connection. Specifically with reference to the recited educational services in the field of pro-life issues and social activism, a prime example illustrating this connection is Terry's twentieth anniversary event, called Operation Rescue XX. Terry described the nature of the event as follows:

> It was to discuss social activism, social tension. It was to instruct people on the history of social revolution, how to work the media. We had breakout sessions on the theology of the body, birth control and different things like that. It was an educational seminar primarily.

(Terry T. 68-69.) *See also* Ex. 42 (promotional brochure stating "come to receive leadership training from proven leaders, training you will need to be an effective warrior and leader in your community and state").

This anniversary event occurred November 2007, 11 months after issuance of the registration, but the Board has stated that evidence of fame after the date of registration may indicate fame before that date. *Hornby,* 87 USPQ2d at 1416; *see also id.* at 1425 (relying on post-registration evidence). Likewise, post-registration evidence of a connection should be considered. Terry was also promoting this event in 2006 or 2007. (Terry T. 109.) No one else but Terry could have held a twentieth anniversary event for Operation Rescue since he was the originator of the name. The event thus reflects back in time and evidences a connection that would have been presumed as of the date of registration. The educational nature of this event was consistent with his other long standing endeavors in that field, as explained in the Statement of Facts. Additionally, apart from education provided through formal seminars or workshops, Terry's career

since November 1987—through public rescues, protests, debates, and even arrests and jail time—has been as a social activist on a mission to educate the public as to pro-life issues. Educating the public was needed to assist in recruiting an ever growing number of activists to participate in rescues and to set the climate for the political, social and legal changes that Terry sought.

Terry contends that the requisite presumed connection for this element is established by the evidence. Alternatively, if this connection has not been shown, Terry's contention as set forth above is that, since Terry has proven fame in the field of pro-life issues and social activism, this connection should be presumed consistent with adapting the principles from Section 2(c) to the application of Section 2(a). The merits for that position are fully set forth above.

As a second alternative, if this connection has not been shown, Terry's contention as set forth above is that Terry need only show a reasonable possibility—consistent with the statutory use of "may"—of this connection between his identity and the subject services. This alternative contention may be independently applied or in addition to the first alternative contention.

G. Newman's Intent In Usurping Terry's Identity

While a showing of Newman's intent is not required to satisfy granting relief to Terry, nevertheless the evidence is compelling that Newman chose the mark Operation Rescue precisely because it was connected with the legacy that Terry created, and thus it had financial and influential drawing power. That intent is shown in Newman's own words. The specimen of use Newman first filed with his application to register the mark

was a webpage from the website operationrescue.org; the principal text was captioned "History of Operation Rescue West" and stated the following in full:

> In 1986, a cadre of men, including Randall Terry and ORW principle members Rev. Joseph Foreman and Ken Reed, founded Operation Rescue. More of a movement than an organization, Operation Rescue led the largest social movement involving civil disobedience in American history. During those early years, thousands of men and women willingly sat in front of abortion mill doors to prevent the killing of innocent children and paid the penalty in arrest and prosecution on trespassing charges.
>
> At that time, many Operation Rescue organizations cropped up across the country, each autonomous in their leadership, including Operation Rescue of Los Angeles and Operation Rescue of San Diego. These two independent groups were never under the authority of Randall Terry, who resigned from Operation Rescue in 1990. From these beginnings, the California Operation Rescue organizations merged into one group, Operation Rescue of California. This group was disbanded after an $ 880,000 judgment was won against them by Planned Parenthood in 1994. Troy Newman immediately founded a new organization, Operation Rescue West, and continues as President of this thriving organization today.

The foregoing "history" is not referenced here for purposes of being in any way factually accurate. Indeed, its account is unsupported by evidence of record and is in conflict with contemporaneous historical accounts in newspapers and reference books that are of record.

What is missing from this "history" is the next step when Newman took his "thriving organization" and renamed it Operation Rescue. What is clear is that the renaming was done to capture what Newman lacks—that long and significant history of the one organization to repeatedly make headlines and draw together the "thousands of men and women" who willingly sacrificed in the "largest social movement involving civil disobedience in American history."

Newman cannot convincingly argue that his choice of Operation Rescue does not point uniquely to the same organization that was founded in 1986, or that persons would

not presume a connection between his mark and the name of the 1986 organization. His own words show that it was his intent to evoke that organization and he even acknowledges that, in his view, Terry was a co-founder of Operation Rescue. Newman's "history" suggests that he is claiming some link to that past organization by having Joseph Foreman and Ken Reed as board members of Operation Rescue West; however, there is no evidence in this case to support that board membership. Further, there is no evidence in this case to show that Messrs. Foreman or Reed provided to Newman any kind of assignment, consent, authorization, or other permission with regard to the use or registration of Operation Rescue. Newman alone is the registrant, not any other person or entity.

Newman's motive for choosing Operation Rescue is obvious. On August 26, 2009, an article in the Los Angeles Times reported on Terry, Newman, and this very cancellation proceeding; the reporter succinctly summarized the obvious:

> Operation Rescue is a name worth fighting for; Whoever controls it benefits from its unquestionable ability to raise money from those who oppose abortion.

Terry's First Not. Reliance ¶ 70. There is, moreover, additional evidence supporting the inference that Newman usurped the name Operation Rescue for financial gain. Terry presented testimony and documentary evidence (copies of checks) to show that he has, since 1987 and into 2007, regularly received checks made payable to Operation Rescue. (Terry T. 150-51 & Ex. 52.) He has also received letters that were either addressed to Newman but mailed to Terry or that made statements evidencing the sender's confusion as to the activities and fundraising of Terry and Newman. (Terry T. 152-53 & Ex. 30.) Terry has also spoken directly to persons who sent money to Newman that was intended for Terry. (*Id.* 154.) Given this state of affairs as experienced by Terry, the reasonable

inference is that Newman too receives money intended for Terry and that such receipt motivated Newman's change of name to Operation Rescue. In that regard, Newman must have welcomed the news in 2006 when Terry's long-running efforts through three U.S. Supreme Court decisions cleared the name of Operation Rescue from the various charges of lawsuits including racketeering.

Further evidence of Newman's intent for financial gain was reported in a Washington Post news article on September 15, 2009 based on interviews with Newman. Terry's First Not. Reliance ¶ 57. The article's pithy headline reads: "Operation Rescue says it's broke, may shut down." (*Id.*) Although identified as Operation Rescue, the report is about Newman and further states that the Internal Revenue Service revoked his Operation Rescue's tax-exempt status in 2006 based on events in 2004. While Newman is quoted as saying that this revocation did not affect donations, that result may not have been so clear when Newman filed to register the mark on May 16, 2005. That filing was a means of covering his bases for a potential future drop in donations. Overall, there is clearly sufficient evidence to warrant the inference that financial considerations motivated Newman's adoption as a mark of the well-known name Operation Rescue.

CONCLUSION

Based on the foregoing facts and arguments, Terry submits that the subject registration of the mark OPERATION RESCUE is barred by Section 2(a), and, accordingly, Terry's petition should be granted and the registration cancelled.

Date: June 17, 2011

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APPENDIX: EVIDENTIARY OBJECTIONS

Terry submits the following objections to the evidence submitted by Newman. Terry objects to his responses to admission requests in Exhibit J to Registrant's Second Notice of Reliance; specifically requests nos. 444-54 and 488-91. In the first batch, each request is in the following form: "Admit that Petitioner was not the leader of any entity or organization doing business under a name which included the OPERTION RESCUE mark in [date]" with dates inserted from 1996 to 2005. In the second batch, each request has the following preamble: "Admit that, during the time period in which Petitioner claims to have used the OPERATION RESCUE mark in commerce …."

There are two flaws to these admission requests. First, Terry's case is based solely on Section 2(a) and thus any reference to Petitioner's mark is irrelevant. The statutory Sections 2(a) and 2(d) are not related. *See, e.g., Hornby,* 87 USPQ2d at 1424. Second, when the Board granted Terry's motion to amend the pleading to assert only Section 2(a), the Board ruled that the prior bases for cancellation, including Section 2(d), were dismissed with prejudice. Order November 14, 2008, p. 6 (Paper # 27). Thus these admission requests (made prior to the Board's ruling) have no probative value to the issues in this case under Section 2(a).

Terry makes the following objections with respect to Registrant's First Notice of Reliance. Terry objects to all of the Exhibits therein as hearsay if offered to prove the truth of the statements therein.

Terry objects to all three entries from Wikipedia at Exhibit B dealing with the History of Operation Rescue, Operation Save America and Randall Terry. Whatever the admissibility or utility of entries from Wikipedia in other cases, those considerations are not present here when several witnesses with first hand knowledge of those subjects

testified and were cross-examined. Messrs. Benham and Thomas, as identified in the Description of the Record, are the director and assistant director of Operation Save America. Witnesses with first hand knowledge of the other subjects include Terry and, for Newman, Messrs. White and Mahoney. Newman, by counsel, could have, if desired, prepared direct testimony or cross-examination guided by the information in Wikipedia, but that information should now not have sufficient probative weight to be admissible in light of the actual testimony presented.

Terry objects to all 10 articles at Exhibit F. Newman's Notice states (p. 10): "These documents relate or refer to other spokespersons or CEOs associated with various trademarks, and are relevant to the issues of whether the name Operation Rescue points uniquely to Petitioner and whether use of the name causes a presumption of a connection with Petitioner." The articles discuss Bill Gates, Lee Iacocca and Steve Jobs, for example, and none discuss the parties or the name Operation Rescue. First, the articles deal with trademarks which are irrelevant to this case as stated above. More importantly, the articles have no probative value whatsoever. The subject of how other spokespersons and associated trademarks impact on the public, and how that impact relates to the parties and issues herein, would require, if even possible, an opinion of an expert concerning the socio-cultural perceptions of the public with respect to this subject matter. Any argument based on these articles is unfounded and simply conjecture.

Terry objects to all four of the entries at Exhibit G, except G-1 which is an entry from a dictionary. The remaining three entries, as described by Newman, relate to "the use of the term 'operation' as a military signifier." Again, as with the entries at Exhibit F, the entries do not discuss the parties or the name Operation Rescue and thus have no probative value whatsoever. As in Exhibit F, Newman is offering some socio-cultural perception which would require, if even possible, an opinion of an expert. Any argument based on these articles is unfounded and simply conjecture.

Terry objects to all 62 entries at Exhibit H which allegedly "refer or relate to the use of the name Operation Rescue by third parties …." These alleged uses by third parties do not relate at all to any pro-life issues which is the subject matter of Newman's recited educational services. In *Hornby,* the respondent similarly offered evidence of third-party use for goods or services that did not "even remotely relate[] to clothing"

which was the goods at issue. 87 USPQ2d at 1427. The Board ruled that evidence had "no probative value" in connection with the issues under Section 2(a). *Id.* Similarly here, Newman's entries have no value and need not be considered. Terry also objects to all of these entries from foreign sources as having no relevant value without additional evidence showing public awareness within the United States. *See White,* 73 USPQ2d at 1719; *In re Urbano,* 51 USPQ2d 1776, 1778 n. 3 (TTAB 1999).

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The foregoing concludes Terry's evidentiary objections. As a different issue, however, the Board's Order of December 2, 2010 (Paper # 63) deferred ruling on Newman's motion to strike the testimony of Terry taken September 30, 2010 and requested that the parties argue the issues in their briefs. The issues raised in Newman's motion to strike are his evidentiary objections, and it is presently unknown if Newman will maintain this objection in his brief and what, if any, facts or arguments will be raised. For this reason, Terry reserves the right to respond in his rebuttal brief to Newman's objection, if made.

Nevertheless, Newman's original motion was rooted in the events during Terry's testimony when Newman entered the room with Patrick Mahoney, with no prior communication of Mahoney's attendance, and Terry, by counsel, stated the position that Mahoney should not attend in order for the testimony to continue. Mahoney left and Terry's direct testimony and cross-examination continued for several hours. The only facts on this issue, of which Terry is aware, are within the trial transcript (Terry T. 6, 8-9, 269) and Terry's own declaration (filed in response to Newman's motion) and adopted as his testimony on April 7, 2011 to explain his reasons for objecting to Mahoney's attendance. (Terry T. 270-71 & Ex. 1). Although Mahoney testified later in the case, no questions were directed to his prior attendance or the events on September 30. Newman, himself, did not testify at all. Accordingly, Newman's present position to support his objection is unclear.

Newman's original position in his motion was that Terry "refused to testify" and therefore drastic relief was warranted. That position is unsound as Terry clearly did not

refuse to testify and therefore sanctions are not warranted. *See Notre Dame,* 217 USPQ at 510 n. 11.

Newman may argue, without factual support, that Mahoney was present to assist Newman, but the record shows that Newman departed the deposition even before Terry's cross-examination began. (Terry T. 140.) Mahoney's presence could just as well have been calculated for shock value to disrupt Terry's testimony. The record shows that, upon Mahoney's entrance into the room, Terry immediately interrupted his testimony and requested a break. During that break, the parties took their positions as later stated on the record. In other words, it is clear that Terry wanted the situation resolved immediately.

The events regarding Mahoney are due to Newman's own making. Even as a courtesy, Terry should have been informed by a prior request for Mahoney's attendance and certainly at least a prior notice of Mahoney's expected attendance. As set forth in the parties' prior motions, there is a dearth of case law covering this situation of an unannounced attendance by a non-party at a testimonial deposition and what to do if the party objects to that attendance. It is Terry's position that this dearth reflects the fact that a prior request or notice has worked in the past to defuse these situations, and that lesson, rather than any drastic sanction, is the appropriate approach to be applied here.

Date: June 17, 2011

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Certificate of Service

This is to certify that a copy of the foregoing was served this 17th day of June 2011 by email and first-class mail, postage prepaid, on the following:

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